DELUXE CATERERS PRIVATE LTD
v. FOOD STACK CONCEPTS PTE LTD

HIGH COURT MALAYA, KUALA LUMPUR
AZLAN SULAIMAN JC
[ORIGINATING SUMMONS NO: WA-24IP-10-07-2023]
10 JANUARY 2024

Abstract – *(i) An aggrieved person, under the law of trademarks, is someone who has used his mark as a trademark or who has a genuine and present intention to use his mark as a trademark, in the course of a trade which is the same as or similar to the trade of the owner of the registered trademark that he wants to remove from the Register of Trademarks. The person must also have a legal interest and rights or legitimate expectation on its own marks and that it is substantially affected by the presence of the registered mark; (ii) One single act of use is sufficient to defeat an application to revoke a trademark for non-use; (iii) The purpose of registering a trademark is for the trademark to be actively used and exploited. The fact that s. 46(1)(a) of the Trademarks Act 2019 provides for revocation for non-use within three years of registering a trademark means that Malaysia is serious about prompt actual use of trademarks upon registration; (iv) The provisions for revocation of a mark do not empower the court to order the same to be transferred to an aggrieved person.*

INTELLECTUAL PROPERTY: *Trade marks – Revocation – Application for – Company started restaurant in India in 1972 – Restaurant now opened in other countries – Company wanted to open restaurant in Malaysia – Discovery that trademark had been registered in Malaysia – Company sought to revoke registration of mark in Malaysia from Register of Trademarks, Malaysia – Whether company 'aggrieved person' – Whether there was prima facie three-year period of non-use of trademark – Whether there were proper reasons for non-use of trademark – Trademarks Act 2019, s. 46(1)(a) & (b)*

INTELLECTUAL PROPERTY: *Trade marks – Invalidation – Application for – Company started restaurant in India in 1972 – Restaurant now opened in other countries – Company wanted to open restaurant in Malaysia – Discovery that trademark had been registered in Malaysia – Company sought to invalidate trade mark – Whether company's trademark a well-known trademark – Whether there was fraud or misrepresentation upon Registrar of Trademarks, Malaysia at time of application to register trademark – Trademarks Act 2019, ss. 47(1), (3) & (6), 76(3) & (4)*

The Copper Chimney restaurant was first opened in 1972 in India. Fifty years later, around 20 Copper Chimney restaurants had since opened in India, with two in Dubai, UAE and one each in the United Kingdom and

Kuwait. While exploring the idea of opening Copper Chimney restaurants in Malaysia, the plaintiff discovered that the defendant had already registered in Malaysia, Trademark No. 2014007985, a stylised word mark in class 43 for 'Services for providing food and drink; temporary accommodation; all included in class 43' ('defendant's mark'). Nevertheless, the plaintiff's further inquiries suggested that despite registering the defendant's mark, the defendant had neither opened nor operated any restaurant under the name 'Copper Chimney' in Malaysia. Determined to proceed with its plan, the plaintiff, by this originating summons ('OS'), applied: (i) under s. 46(1)(a) and (b) of the Trademarks Act 2019 ('Act') to revoke the registration of the defendant's mark from the Register of Trademarks, Malaysia ('Register'); and (ii) further and/or in the alternative, to invalidate the defendant's mark under several provisions of the Act, namely s. 47(1), (3) and (6) and/or s. 76(3) and (4) of the Act. The plaintiff contended, *inter alia*, that: (i) because the defendant's mark was registered in Malaysia, the plaintiff was unable to register so as that may constitute infringement of the defendant's mark and expose the plaintiff to trademark infringement proceedings; and (ii) a search on the Google platform using the keywords 'Copper Chimney Malaysia' did not reveal any results of the use of the defendant's mark or any such restaurant named 'Copper Chimney' operating in Malaysia ('Google search'). Further, a search on the defendant's company with the Companies Commission of Malaysia ('CCM'), revealed that a company called Copper Chimney Sdn Bhd had been incorporated on 26 June 2019, but its status was 'dissolved' ('CCM search'). The defendant submitted that (i) the plaintiff was not an aggrieved person because it had not actually used the marks within Malaysia; and (ii) despite the absence of any restaurant in Malaysia operating under the name of 'Copper Chimney', the defendant alleged that it had nevertheless established use of the defendant's mark in Malaysia by (a) its restaurants in Singapore which had received multiple awards, recognition and good reviews; and (b) significant amount of marketing and advertising of its restaurants online and through social media; (iii) the reasons for the non-use of the defendant's mark in Malaysia were: (a) the defendant had applied to register the defendant's mark and was actually approached by a business owner to operate the Copper Chimney franchise in Malaysia. However, the proposal did not come to fruition as the business owner wanted to serve alcohol in the Malaysian outlets, which was not in tandem with the defendant's vision to cater to predominantly Muslim clientele; (b) the intention to open a restaurant in Malaysia did not materialise due to the COVID-19 pandemic, which also caused the dissolution of Copper Chimney Sdn Bhd; and (c) there was a letter of intent and a partnership proposal from a Malaysian businessman looking to explore working together with the defendant to open Copper Chimney restaurants in Malaysia ('defendant's reasons for non-use of defendant's mark'). The issues that arose were: (i) whether the plaintiff was aggrieved by the defendant's mark; (ii) whether the plaintiff had established *prima facie* non-use; (iii) whether the defendant

had used the defendant's mark for services in class 43 during any of the relevant periods; (iv) whether the defendant had proffered any proper reasons for non-use; and (v) whether the defendant's mark ought to be invalidated.

Held (allowing originating summons in part):

(1) As s. 46(1) of the Act clearly provides that the court may order revocation of a registered trademark 'on the application of an aggrieved person', even before considering whether there has been non-use of the defendant's mark in Malaysia under either limbs (a) or (b), the plaintiff as an applicant must first and foremost be required to establish that it is an aggrieved person. In this case, if the plaintiff had already opened its restaurant in Malaysia using the plaintiff's marks, then it would have exposed itself to the defendant's allegations of trademark infringement. That in itself would have deprived the plaintiff of the opportunity to regard itself as an aggrieved person and consequently, the ability to even resort to s. 46 of the Act to apply to revoke the defendant's mark. The plaintiff was indeed an aggrieved person under s. 46(1) of the Act. This finding opened the way to considering whether there had been non-use of the defendant's mark in Malaysia. (paras 12, 23 & 27)

(2) The two evidences, *ie*, the Google search and the CCM search, established that, *prima facie*, the defendant had not put the defendant's mark to use in good faith in Malaysia for the period of three years from 28 September 2015 to 27 September 2018 and also that the use of the defendant's mark had been suspended for a period of three years from at least 26 July 2020 to 25 July 2023. (para 30)

(3) Section 46(1) of the Act clearly stipulates that the trademark in issue must be put to actual use in Malaysia. One single act of use was sufficient to defeat an application to revoke a trademark for non-use. On the defendant's own evidence, the defendant could only show use of the defendant's mark in Singapore and not a single use in Malaysia. Had there been an outlet in Malaysia, it would have mentioned it and those establishments in Singapore would have been irrelevant and immaterial. The word 'trade' is there for a reason. Black's Law Dictionary defines 'trade' as the business of buying and selling or bartering goods or services'. It only stands to reason that a trademark fulfils its underlying purpose when there is actual commercial activity using the trademark. In other words, commercial exploitation. That necessarily means that the use has to be publicly and outwardly. The defendant, on the other hand, had not used the defendant's mark in Malaysia at all during the periods of either 28 September 2015 to 27 September 2018 or at least from 26 July 2020 to 25 July 2023. (paras 34-36 & 42-43)

(4) The defendant's reasons for non-use of the defendant's mark did not constitute proper reasons for non-use under both limbs (a) and (b) of s. 46(1) of the Act, for the following reasons: (i) the purpose of

registering a trademark is for the trademark to be actively used and exploited. The fact that s. 46(1)(a) of the Act provides for revocation for non-use within three years of registering a trademark means that Malaysia is serious about prompt actual use of trademarks upon registration; (ii) the defendant's own narration of events showed lapse of around two years from the registration of the defendant's trademark in 2015 to the defendant's first expression of wanting to use it in Malaysia in 2017. Even then, it was not on the defendant's own volition but instigated by a proposal from a business owner to operate the Copper Chimney franchise in Malaysia. When that did not materialise, it was over a year later, on 18 December 2018 – thus, over four years after the defendant had applied to register the defendant's trademark and over three years after the certificate of registration for it was issued – that the defendant appointed a consultant to register a company in Malaysia and explore opening a flagship store in Malaysia. It took another six months to register the Malaysian company with still no evidence of any definitive plans to open a restaurant in Malaysia; (iii) the effects of the COVID-19 pandemic truly struck in early March 2020, which was over six years after the defendant had applied to register the defendant's trademark and over five years after the certificate of registration for it was issued. In all that time, there was no use at all of the defendant's mark in Malaysia and no services were offered by the defendant for any of the services for which the defendant's mark was registered; (iv) apart from incorporating Copper Chimney Sdn Bhd on 27 June 2019, the defendant did not adduce any evidence of even being near to opening a restaurant using the defendant's mark up to the time the plaintiff filed this OS, or details of how the pandemic had stopped in its tracks; and (v) the defendant had not disclosed any further developments after the letter of intent and the partnership proposal. Surely if the plaintiff was serious about opening a Copper Chimney restaurant locally, there would have been some developments. (paras 49-53, 56 & 57)

(5) In respect of an application under s. 47(3), read with s. 24(3) of the Act and under s. 76(3) and (4) of the Act, an applicant would have to show that its trademark is a well-known trademark. Based on the plaintiff's own documents and evidence, the plaintiff failed to adduce any sufficient evidence for the court to hold that any of the plaintiff's marks were well-known trademarks. Consequently, the plaintiff's attempt to invalidate the defendant's mark under these provisions of the Act failed. That left the court to consider the plaintiff's application to invalidate the defendant's mark under ss. 47(1) and 47(6) of the Act. To successfully invoke s. 47(6) of the Act, the plaintiff would have to establish that at the time the defendant applied to register the defendant's mark in Malaysia, it practiced a fraud or misrepresentation upon the Registrar. Given that at the time the defendant applied to register the defendant's mark, the plaintiff was only operating one restaurant outlet in India and

had not opened any outlets outside India and had not put to actual use the trademarks it had registered in the UAE, Kuwait and Australia and the plaintiff's marks were not well-known trademarks, there was no fraud by the defendant in the registration of the defendant's mark in Malaysia, and the registration of the defendant's mark in Malaysia was not obtained by misrepresentation on either the Registrar or on the general public. (paras 59, 69, 92 & 107)

(6) The plaintiff could not be the legal owner of the 'Copper Chimney' trademark in Malaysia because it was registered by the defendant and the provisions for revocation of the defendant's mark do not have provisions empowering the court to order it to be transferred to the plaintiff. As the plaintiff had succeeded in its application to revoke the defendant's mark under ss. 46(1)(a) and (b) of the Act, only that part of the prayer in the OS in relation to recording the revocation of the defendant's mark in the Register was allowed. (paras 110 & 124)

Case(s) referred to:

"ELBA" SpA v. Fiamma Sdn Bhd [2008] 8 CLJ 202 HC ***(refd)***
Asos Pic v. Anson's Herrenhaus KGBerliner [2014] Lexis Citation 2822 ***(refd)***
Aspect Synergy Sdn Bhd v. Banyan Tree Holdings Ltd [2009] 8 CLJ 97 HC ***(refd)***
Comic Enterprises Ltd v. Twentieth Century Fox Film Corporation (No. 2) [2014] EWHC 185 ***(refd)***
Daimler AG v. Sany Group Co Ltd [2009] All ER (D) 128 ***(refd)***
e-Toyo Global Stationery Sdn Bhd v. Toyo Ink Sdn Bhd & Anor [2004] 7 CLJ 368 HC ***(refd)***
Fazaruddin Ibrahim v. Parkson Corporation Sdn Bhd [1997] 2 CLJ 863 HC ***(refd)***
Hai-0 Enterprise Bhd v. Nguang Chan [1992] 4 CLJ 1985; [1992] 2 CLJ (Rep) 436 HC ***(refd)***
Jost Cranes GmbH & Co KG v. Jost Cranes Sdn Bhd [2010] CLJU 331; [2010] 1 LNS 331 HC ***(refd)***
LB (Lian Bee) Confectionery Sdn Bhd v. QAF Ltd [2012] 3 CLJ 661 FC ***(refd)***
Lim Yew Sing v. Hummel International Sports & Leisure A/S [1996] 4 CLJ 784 CA ***(refd)***
Liwayway Marketing Corporation v. Oishi Group Public Co Ltd [2017] 5 CLJ 133 FC ***(refd)***
McLaren International Ltd v. Lim Yat Meen [2009] 4 CLJ 749 FC ***(refd)***
Mesuma Sports Sdn Bhd v. Majlis Sukan Negara Malaysia; Pendaftar Cap Dagangan Malaysia (Interested Party) [2015] 9 CLJ 125 FC ***(refd)***
Re Arnold D Palmer In the Matter of Trade Mark Registration No 63249 [1986] CLJU 11; [1986] 1 LNS 11 ***(refd)***
Syarikat Zamani Hj Tamin Sdn Bhd & Anor v. Yong Sze Fun & Anor [2006] 5 MLJ 262 ***(refd)***
TCE Sports Sdn Bhd v. Bullzen Sport (Malaysia) Sdn Bhd [2023] CLJU 379; [2023] 1 LNS 379 HC ***(refd)***
The Walt Disney Company v. Rossell Fantasy Works [2008] Lexist Citation 3383 ***(refd)***
Tiga Gajah Cho Heng Sdn Bhd v. Majuperak Tepung Beras Sdn Bhd [1997] 1 CLJ Supp 52; [1997] 1 BLJ 52 HC ***(refd)***
Trojan Recordings Ltd v. ARCO Ltd [2014] Lexis Citation 3875 ***(refd)***
Yong Teng Hing B/S Hong Kong Trading Co & Anor v. Walton International Ltd [2012] 6 CLJ 337 FC ***(refd)***

Legislation referred to:
Rules of Court 2012, O. 59 r. 3
Trademarks Act 2019, ss. 3(1), 4(2), 23(5)(a), 24(3), 36(2), (3), 45(1)(a), 46(1)(a), (b), 47(1), (3), (6), 76(3), (4), (5)
Trademarks Regulations 2019, reg. 5
Trade Marks Regulations 1997, reg. 13B

For the plaintiff - Steven Cheok & Soo An Qi; M/s Christopher & Lee Ong
For the defendant - Pathma Raj Ramasamy; M/s Pathma Raj Ramasamy & Co

Reported by Lina E

JUDGMENT

Azlan Sulaiman JC:

Introduction

[1] On a balmy night in Worli, Bombay (as Mumbai was then known) in 1972, the excitement in the air was palpable. Legendary actor, Dilip Kumar, who dominated the Hindi film industry in the late 40, 50s and 60s, was JK Kapur's honoured guest at the grand opening of the latter's inaugural and flagship restaurant called 'Copper Chimney'.

[2] Fast forward 50 years. Around 20 Copper Chimney restaurants have since opened in India, with a further two in Dubai, UAE and one each in the UK and Kuwait. The plaintiff has further registered trademarks containing the word 'Copper Chimney' in those countries and in Australia. However, while exploring the idea of opening 'Copper Chimney' restaurants in Malaysia, the plaintiff discovered that the defendant had already registered in Malaysia Trademark No. 2014007985, a Stylized Word Mark in class 43 for "services for providing food and drink; temporary accommodation; all included in class 43" ("defendant's mark") that looks like this:

"COPPER CHIMNEY"

[3] Nevertheless, the plaintiff further inquiries suggested that, despite registering the defendant's mark, the defendant had neither opened nor operated any restaurant under the name 'Copper Chimney' in Malaysia.

[4] Determined to proceed with its plan to get share the joys of its delicious cuisine with Malaysians and as a gateway to the rest of ASEAN, by this originating summons ("OS"), the plaintiff is applying:

(i) under s. 46(1)(a) and (b) of the Trademarks Act 2019 ("Act") to revoke the registration of the defendant's mark from the Register of Trademarks, Malaysia ("Register"); and

(ii) further and/or in the alternative, to invalidate the defendant's mark under several provisions of the Act, namely ss. 47(1), (3) and (6) and/or ss. 76(3) and (4).

[5] In Part B of this judgment, I will deal with the plaintiff's revocation application and in Part C its application to invalidate the defendant's mark under all of those provisions. In Part D I will set out the relief sought and the orders made.

Revocation Of The Defendant's Mark Under Section 46 Of The Act

[6] Section 46 of the Act is the provision for revoking the registration of a trademark on the ground that it has not been used, *ie*, for non-use. The application is made to court and, if it is allowed, the order for revocation is made by the court, which the Registrar of Trademarks, Malaysia ("Registrar") then carries out.

[7] Section 46 of the Act provides:

> (1) The registration of a trademark may be revoked by the court on an application by an aggrieved person on any of the grounds as follows:
>
> (a) where within a period of three years following the date of issuance of the notification of registration, the trademark has not been put to use in good faith in Malaysia, by the registered proprietor or with his consent, in relation to the goods or services for which the trademark is registered, and there are no proper reasons for non-use;
>
> (b) where the use of the goods or services under paragraph (a) has been suspended for an uninterrupted period of three years, and there are no proper reasons for non-use;

[8] Section 46(1) makes it clear that only an aggrieved person can invoke it. However, just before discussing whether the plaintiff is an aggrieved person and going into the merits of the revocation application, it may be expedient to examine the nuances and differences between an application under limbs (a) and (b) of s. 46. After all, in *McLaren International Ltd v. Lim Yat Meen* [2009] 4 CLJ 749, Abdul Aziz Mohamad FCJ said:

> The grounds in paras (a) and (b) are independent alternative grounds that are not related to one another.

Limb (a)

[9] Under limb (a), the three-year period of non-use of the trademark in issue is pegged to the "notification of registration", which under s. 36(2) of the Act the Registrar issues to the successful applicant/proprietor. Under s. 36(3) of the Act, a certificate of registration is equivalent to a notification of registration issued under s. 36(2).

[10] In this case, the defendant had applied to register the defendant's mark on 14 July 2014 and the certificate of registration for the defendant's mark is dated 28 September 2015. Consequently, for the purpose of limb (a), the plaintiff would have to show that the defendant had not put the defendant's

mark to use in good faith in Malaysia for a period of three years from 28 September 2015 to 27 September 2018, and that there are no proper reasons for non-use of the defendant's mark during that period.

Limb (b)

[11] Under limb (b), the plaintiff would have to show that the use of goods and services under the defendant's mark in Malaysia had been suspended for an uninterrupted period of three years from at least 26 July 2020 to 25 July 2023 and that there are no proper reasons for non-use of the defendant's mark. The latter date of 25 July 2023 is taken because the OS was filed on 26 July 2023.

[12] Coming back to "aggrieved person". As s. 46(1) of the Act clearly provides that the court may order revocation of a registered trademark "on the application of an aggrieved person", even before considering whether there has been non-use of the defendant's mark in Malaysia under either limbs (a) or (b), the plaintiff as applicant is first and foremost required to establish that it is an aggrieved person. It the plaintiff fails to do so, then the issue of non-use of the defendant's mark under either limb for either period need not been considered, and the OS would be dismissed.

[13] Thus, the three issues to be considered for the plaintiff's application to revoke the registration of the defendant's mark are:

(i) whether the plaintiff is an aggrieved person in relation to the defendant's mark;

(ii) if so, whether the plaintiff has established *prima facie* that the defendant did not use the defendant's mark in Malaysia for goods in class 43 for both of those periods of time prescribed by both limbs (a) and (b); and

(iii) if so, whether the defendant can show that it did use the defendant's mark in Malaysia for both of those periods of time for goods in class 43, or provide proper reasons for non-use.

Whether The Plaintiff Is Aggrieved By The Defendant's mark

[14] In *Fazaruddin Ibrahim v. Parkson Corporation Sdn Bhd* [1997] 2 CLJ 863; [1997] 4 MLJ 360, Abdul Malik Ishak J expressed the view that any person whose application to register a trademark has been thwarted by the trademark it wishes to challenge would be aggrieved. He said:

> The phrase 'person aggrieved' in s. 45(1)(a) of the Act should be construed liberally. In my judgment, it includes any person whose own application for registration is obstructed by the opposing party in the suit ...

[15] In *Re Arnold D Palmer In the Matter of Trade Mark Registration No* 63249 [1986] CLJU 11; [1986] 1 LNS 11; [1987] 2 MLJ 681, the Singapore High court held that the mere filing of an application to register a trademark would not make that person an aggrieved person, and that there must be more. Chan Sek Keong JC said:

> The registration of a trade mark in the name of a proprietor, once effected, ought not to be disturbed by persons who have no trading interest in the goods concerned. If an applicant for rectification has no such interest to begin with, and therefore cannot suffer any damage at all by the existence of a conflicting trade mark on the register, it cannot be right, in principle, that the mere filing of his application can confer the necessary locus standi on the applicant for the purpose of rectifying proceedings.
>
> Otherwise, the test of grievance prepounded in *Powells TM* (1894) 11 RPC 7; [1894] AC 8 would be completely nullified by resorting to the simple expediency of applying to register the very mark the applicant seeks to expunge.

[16] In *McLaren International Ltd v. Lim Yat Meen* [2009] 4 CLJ 749, Abdul Aziz Mohamad FCJ referred to Fazaruddin bin Ibrahim and said:

> A person whose application for registration of his trademark is jeopardised by s 19(1) cannot, without more, qualify as a person aggrieved, because he could be a mere busybody.

[17] Referring then to the passage in *Re Arnold D Palmer*, Abdul Aziz Mohamad FCJ said:

> We understand that passage as laying down the principle that a person aggrieved is a person who has used his mark as a trade mark – or who has a genuine and present intention to use his mark as a trade mark – in the course of a trade which is the same as or similar to the trade of the owner of the registered trade mark that the person wants to have removed from the register.

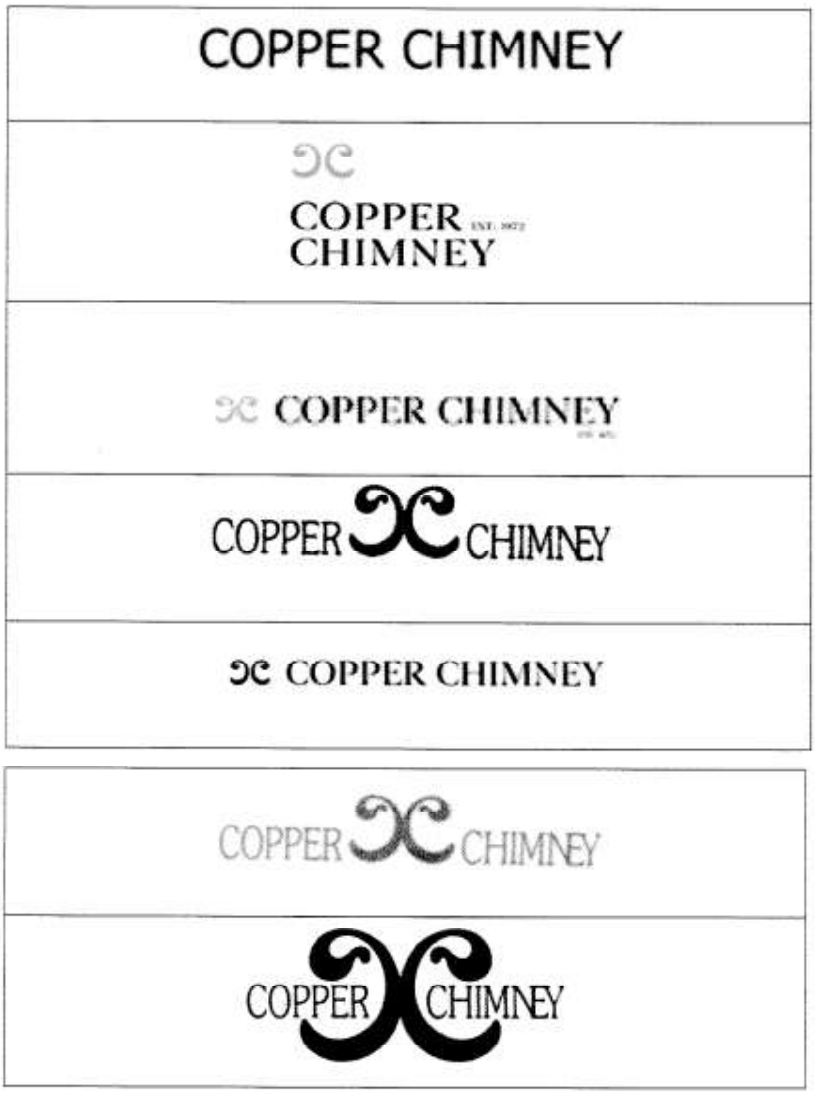
[18] Then, in *Mesuma Sports Sdn Bhd v. Majlis Sukan Negara Malaysia; Pendaftar Cap Dagangan Malaysia (Interested Party)* [2015] 9 CLJ 125; [2015] 6 MLJ 465, Azahar Mohamed FCJ (later CM (Malaya) concurred with and echoed what Abdul Aziz Mohamad FCJ had said in *McLaren International*, and then added:

> The person must be someone who has some element of legal interest, right or legitimate expectation in its own mark which is being substantially affected by the presence of the registered trade mark. The interest and right must be legal or lawful.

[19] Thus, an aggrieved person is someone who has used his mark as a trademark, or who has a genuine and present intention to use his mark as a trademark, in the course of a trade which is the same as or similar to the trade of the owner of the registered trademark that he wants to remove from the register. The person must also have a legal and legal interest, right or legitimate expectation in its own mark and that it is substantially affected by the presence of the registered mark. The next task is to see whether the plaintiff fits the bill.

[20] The plaintiff adduced evidence of the trademarks it has used and registered in India, UK, Kuwait and UAE (collectively, "plaintiff's marks"), that it wants to use for the restaurants that it wishes to open here. What they each look like is set out below:

A



B

C

D

E

F

G

H

[21] The plaintiff says that, because of the defendant's mark that is registered here, it is unable to do so at present as that may constitute infringement of the defendant's mark and expose the plaintiff to trademark infringement proceedings.

I

[22] The defendant contends that the plaintiff is not an aggrieved person because it has not actually used the plaintiff's marks within Malaysia. For this, the defendant relies on *Liwayway Marketing Corporation v. Oishi Group Public Co Ltd* [2017] 5 CLJ 133.

[23] I do not agree with the defendant's contention. Firstly, if the plaintiff had already opened its restaurant in Malaysia using the plaintiff's marks, then it would have exposed itself to defendant's allegations of trademark infringement. That in itself would have deprived the plaintiff of the opportunity to regard itself as an aggrieved person and consequently the ability to even resort to s. 46 of the Act to apply to revoke the defendant's mark. That was what happened in *LB (Lian Bee) Confectionery Sdn Bhd v. QAF Ltd* [2012] 3 CLJ 661.

[24] In that case, QAF was registered as the proprietor of the trademark "Squiggles" under class 30. However, Lian Bee had been using that mark in Malaysia and had applied to expunge QAF's mark, under s. 46(1)(b) of the Trade Marks Act, 1976 that was then in force. QAF opposed Lian Bee's application alleging that, because Lian Bee was already infringing its trademark, it was not an aggrieved person and that, as an infringer of intellectual property rights, the court should not assist it. The Federal Court held that, on the principle of construction in *bonam partem*, an infringer of a trademark could not be regarded as an aggrieved person because that would be contrary to the time-honoured principle that a person cannot benefit from their very own wrong or unlawful act. In para. [18] of the judgment, Zulkefli CJ Malaya said:

> In accordance with the principle of construction in *bonam partem*, it is noted that the learned trial judge had found that the appellant had been infringing the registered trademark 'squiggles' since 2007. The registered trademark 'squiggles' was registered on 20 August 2004. Until its expungement, the registered trademark remains a registered trademark. In this case, even before the application for expungement, the appellant had unlawfully been using the infringing mark 'squiggle' which is confusingly similar to the registered trademark. Applying the principle of construction in *bonam partem*, the appellant cannot be regarded as being a *bona fide* 'person aggrieved' or a person who is lawfully aggrieved for the purposes of s. 46(1)(b) of the TMA. Furthermore, if the appellant is to be regarded as a 'person aggrieved' for the purposes of s. 46(1)(b) of the TMA, it would mean that all infringers may apply to expunge the very trademark they have been infringing and this would be contrary to the time-honoured principle of not allowing them to benefit from their very own wrong or unlawful act.

[25] Thus, if I accept the defendant's contention that use of the plaintiff's marks for those services locally by the plaintiff is a pre-condition to the plaintiff being regarded as an aggrieved person, that would place the plaintiff in a classic catch-22 situation. It would mean that the plaintiff would not be an aggrieved person for not having used the plaintiff's marks locally, and at the same time it would also not be an aggrieved person if it did. Non-aggrieved if you did, non-aggrieved if you didn't. On that basis, no one would be an aggrieved person, and the requirement under s. 46 of the Act

for an applicant to be an aggrieved person could never be made out. As a consequence, s. 46 itself would be rendered redundant and unenforceable. That could never have been the Legislature's intention, to have legislated in vain.

[26] Secondly, the Federal Court in *Liwayway* did not say that an applicant for revocation of a trademark will only be an aggrieved person if it has actually used the trademark it wants to revoke in Malaysia. It only agreed with the proposition that an applicant applying to revoke a registered trademark must show that it has or is using an identical or similar mark (not necessarily in Malaysia) or who has a genuine and present intention to use it in Malaysia.

[27] I accordingly reject these defendant's objections and find that the plaintiff is indeed an aggrieved person under s. 46(1) of the Act. That finding then opens the way to considering whether there has been non-use of the defendant's mark in Malaysia.

Whether The Plaintiff Has Established Prima Facie Non-use

[28] As I said earlier, under s. 46(1) (a) and (b), the plaintiff would have to establish *prima facie* non-use by the defendant's marks for those services under class 43 for a period of 28 September 2015 to 27 September 2018 and of at least 26 July 2020 to 25 July 2023. The law logically requires an applicant under s. 46 of the Act to establish only *prima facie* non-use of the trademark that it seeks to revoke. This is because an applicant cannot be expected to conclusively know of or prove non-use since he would be speaking of the activity in relation to a trademark of someone else.

[29] The plaintiff relies on the following evidence to establish *prima facie* non-use of the defendant's mark for those periods:

(i) a search on the Google platform using the keywords "Copper Chimney Malaysia'' that did not reveal any results of the use of the defendant's mark or any such restaurant named 'Copper Chimney' operating in Malaysia; and

(ii) a search on the defendant's company with the Companies Commission of Malaysia ("CCM") which revealed that a company called Copper Chimney Sdn Bhd had been incorporated on 26 June 2019, but that its status is "dissolved'.

[30] In my view, these two evidence establish that, *prima facie*, the defendant had not put the defendant's mark to use in good faith in Malaysia for the period of three years from 28 September 2015 to 27 September 2018, and also that use of the defendant's mark had been suspended for a period of three years from at least 26 July 2020 to 25 July 2023. For two reasons.

[31] Firstly, as I said earlier, the defendant's mark is registered in class 43 for "services for providing food and drink; temporary accommodation; all included in class 43". In providing those kinds of services, a restaurant or hotel naturally come to mind. Had the defendant actually used the defendant's mark through operating either a restaurant or hotel, then surely in this day and age such business would have appeared in a Google search. A non-result search on the Google platform using the keywords "Copper Chimney Malaysia" would mean that, *prima facie*, Copper Chimney has not been used and is currently not being used by any restaurant or hotel in Malaysia despite the registration of the defendant's mark.

[32] Secondly, had the defendant actually used the defendant's mark in a restaurant or hotel, then in all likelihood surely a company would be running and managing it. Even if the defendant's mark was owned by a foreign entity (like here), then in all likelihood the owner would incorporate a company or subsidiary locally to do so. The defendant did in fact do that. However, the CCM search revealed that Copper Chimney Sdn Bhd (that the defendant incorporated in Malaysia) was only incorporated on 26 June 2019, which is after the expiry of that first three-year period and before the commencement of the second three-year period. And that it is now dissolved.

Whether The Defendant Has Used The Defendant's mark For Services In Class 43 During Any Of Those Periods

[33] The plaintiff having established *prima facie* non-use of the defendant's mark during 28 September 2015 to 27 September 2018 and from at least 26 July 2020 to 25 July 2023, the burden then shifted to the defendant to establish use or proper reasons for non-use of the defendant's mark for those services in class 43 in Malaysia.

[34] In Malaysia, one single act of use is sufficient to defeat an application to revoke a trademark for non-use. In *e-Toyo Global Stationery Sdn Bhd v. Toyo Ink Sdn Bhd & Anor* [2004] 7 CLJ 368, Ramli Ali J said:

> On the question of how much constitutes 'use' for the purpose of s. 46(1) of the Act, the court adopts the decision in *"Nodoz" Trade Mark* [1962] RPC 1, where the High Court of Justice – Chancery Division held that "a single act of sale was considered sufficient".

[35] On the defendant's own evidence, I find that the defendant could only show use of the defendant's mark in Singapore and not a single use in Malaysia. In fact, in para. 11 of the defendant's affidavit in reply to the OS, the defendant's director (who had been appointed its Malaysia Country Manager in January 2023) admitted that, in Singapore, the defendant is "currently operating two restaurants and two school canteens", and he did not depose to any such outlets in Malaysia. Had there been an outlet in Malaysia, he would have mentioned it, and those establishments in Singapore would have been irrelevant and immaterial.

[36] Despite the absence of any restaurant in Malaysia operating under the name 'Copper Chimney' the defendant's alleges that it has nevertheless established use of the defendant's mark in Malaysia by:

(i) its restaurants in Singapore, which the defendant contends are exceedingly popular amongst Malaysian citizens, as many frequently flock to them;

(ii) by the defendant's significant amount of marketing and advertising of its restaurants and services online and through social media; and

(iii) by the fact that its restaurants in Singapore have received multiple awards, recognition and good reviews.

[37] However, I reject these contentions, as s. 46(1) of the Act clearly stipulates that the trademark in issue must be put to actual use in Malaysia.

[38] In *Comic Enterprises Ltd v. Twentieth Century Fox Film Corporation* (No. 2) [2014] EWHC 185 (Ch); *Asos Pic v. Anson's Herrenhaus KGBerliner* [2014] Lexis Citation 2822; *Trojan Recordings Ltd v. ARCO Ltd* [2014] Lexis Citation 3875; *The Walt Disney Company v. Rossell Fantasy Works* [2008] Lexist Citation 3383, and *Service Point Solutions SA v. DHL International GmbH*, the various courts have held that use of a trademark is demonstrated by certain criterion. These include:

(i) actual use and not just token use *ie*, solely to preserve the rights conferred by registration;

(ii) use that is consistent with the essential function of the mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user, without any possibility of confusion, to distinguish the goods or services from others which have another origin;

(iii) the use must be by way of commercial exploitation of the mark on the market for those goods or services, aimed at maintaining or creating an outlet from them or a share of the market;

(iv) the use must be publicly and outwardly; and

(v) internal use by the proprietor and the distribution of promotional items to encourage sale and as a reward for the purchase of other goods is not use.

[39] Locally, in paras. [19] and [20] of his judgment in *Jost Cranes GmbH & Co KG v. Jost Cranes Sdn Bhd* [2010] CLJU 331; [2010] 1 LNS 331; [2010] 4 MLJ 191, Azahar Mohamed J (as His Lordship then was) referred to *Daimler AG v. Sany Group Co Ltd* [2009] All ER (D) 128 and the principles therein to derive the meaning of genuine use. He said:

(a) Genuine use is a qualitative and not a quantitative criterion.

(b) The use has to be consistent with the essential function of the trademark, which is to guarantee the identity of the origin of the goods or services to the customer or end users.

(c) The use has to be on the market by the proprietor or an authorised third party and not just internal use by the undertaking concerned.

(d) The use has to be to maintain or create a share in the market for the goods or services protected by the mark.

(e) The court has to take into consideration all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark has been real, and in particular, whether such use would be viewed as warranted in the trade sector concerned to maintain or create a share in the market for the relevant goods or services protected by the mark. And finally,

(f) The nature of the goods in issue such as the characteristics of the market concerned and the scale and frequency of the use of the mark have to be taken into account.

[40] Further, s. 3(1) of the Act provides the following definition of 'trademark':

> Trademark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of another undertaking.

[41] *Black's Law Dictionary* defines "trademark" as:

> a word, phrase, logo or other graphic symbol used by a manufacturer or seller to distinguish its product or products from those of others. The main purpose of a trademark is to guarantee a product's genuineness. In effect, the trademark is the commercial substitute for one's signature.

[42] The word "trade" is there for a reason too. *Black's Law Dictionary* defines that as "the business of buying and selling or bartering goods or services." It only stands to reason that a trademark fulfils its underlying purpose when there is actual commercial activity using the trademark. In other words, commercial exploitation. That necessarily means that the use has to be publicly and outwardly.

[43] In conclusion, I find that the defendant has not used the defendant's mark in Malaysia at all during the periods of either 28 September 2015 to 27 September 2018 or at least from 26 July 2020 to 25 July 2023.

[44] Before moving on to whether the defendant has proffered any proper reasons for non-use, there is one matter which this court cannot overlook without commenting on it, and views with utmost concern. In para. 20 of the defendant's affidavit, the defendant's director said:

> I state that it is crucial to note that the fame and recognition received by the defendant is not only limited in Singapore but has also spilled over to Malaysia.

A The defendant **has created presence in the market** and the Malaysian consumers are familiar with the defendant where an article by Johor Kaki shows that the Malaysian public has knowledge of **"COPPER CHIMNEY"**.

(emphasis added)

B The defendant adduced that article by Johor Kaki as exh. "K".

[45] The reason why this court views this with utmost concern is that, in response, the plaintiff adduced that very same article, only that the one the plaintiff adduced contained the following words which were wholly absent from exh. "K" of the defendant's affidavit:

C Disclaimer: Please note that this was an invited testing.

[46] If true, that disclaimer undermines the defendant's bold contention that the defendant has created presence in the market and that Malaysian consumers are familiar with the defendant. It means that the writer of D exh. K was actually invited to do a testing and had not gone to the defendant's Copper Chimney restaurant on his own volition or out of his having heard of it, and raises the possibility and suspicion that he may not have written the article independently or voluntarily.

[47] The crucial point is this: it is imperative that parties adduce whole, E unedited documents. If indeed the author of that article went to the defendant's restaurant on an invited testing, then the statement that "Malaysian consumers are familiar with the defendant where an article by Johor Kaki shows that the Malaysian public has knowledge of "COPPER CHIMNEY' is simply not true.

F *Whether The Defendant Has Proffered Any Proper Reasons For Non-use*

[48] In its affidavits, the defendant has proffered several reasons for non-use of the defendant's mark in Malaysia and the intention to use the defendant's mark in Malaysia, which can be summarised as follows:

G (i) in August 2017 (which was over three years after the defendant had applied to register the defendant's mark and two years after the certificate of registration for it was issued), the defendant was approached by a business owner proposing to operate the Copper Chimney franchise in Malaysia. However, that proposal did not come H to fruition as that business owner wanted to serve alcohol in those Malaysian outlets, which was not in tandem with the defendant's vision for its proposed outlets to cater predominantly to Muslim clientele;

(ii) on 18 December 2018, the defendant appointed one Ranjit Jacob as its consultant for Malaysia, whose mandate included registering a company I in Malaysia and opening a flagship outlet in Malaysia. However, even though Copper Chimney Sdn Bhd was incorporated on 27 June 2019,

that intention to open a restaurant in Malaysia did not materialise due to the COVID-19 pandemic, which also caused the dissolution of Copper Chimney Sdn Bhd; and

(iii) in January 2023, the defendant appointed one Manoj Bavadekar as Malaysia Country Manager to explore and spearhead starting a chain of Copper Chimney restaurants in Malaysia. This resulted in the defendant receiving a letter of Intent dated 7 April 2023 and a partnership proposal dated 2 May 2023 from a Malaysian businessman looking to explore working together with the defendant to open Copper Chimney restaurants in Malaysia.

[49] However, in my view, these reasons do not constitute proper reasons for non-use under both limbs (a) and (b) of s. 46(1) of the Act.

[50] Firstly, as elucidated earlier, the purpose of registering a trademark is for the trademark to be actively used and exploited. The fact that s. 46(1)(a) of the Act provides for revocation for non-use within three years of registering a trademark means that Malaysia is serious about prompt actual use of trademarks upon registration. By comparison, in the UK and Singapore, the period of non-use for revocation purposes is five years.

[51] Secondly, the defendant's own narration of events shows a lapse of around two years from the registration of the defendant's Trademark in 2015 to the defendant's first expression of wanting to use it in Malaysia in 2017. Even then, it was not on the defendant's own volition but instigated by a proposal from a business owner to operate the Copper Chimney franchise in Malaysia.

[52] Thirdly, when that did not materialise, it was over a year later on 18 December 2018 – thus over four years after the defendant had applied to register the defendant's Trademark and over three years after the certificate of registration for it was issued – that the defendant appointed a consultant for Malaysia to register a company in Malaysia and explore opening a flagship store in Malaysia. It took another six months to register the Malaysian company, with still no evidence of any definitive plans to open a restaurant in Malaysia.

[53] Fourthly, the effects of the COVID-19 pandemic truly struck in early March 2020, which was over six years after the defendant had applied to register the defendant's trademark and over five years after the certificate of registration for it was issued. In all that time, there was no use at ail of the defendant's mark in Malaysia, and no services offered by the defendant for any of the services for which the defendant's mark was registered.

[54] Fifthly, in my view, the COVID-19 pandemic does not offer the defendant any respite. It might have had the defendant been in advanced, final stages of preparation for actually opening a Copper Chimney restaurant in Malaysia, but the defendant's own evidence did not show that to be the case at all.

[55] In the United Kingdom case of *Trade Mark Inter Partes Decision* 0/350/22, the UK Trademark Registry had considered COVID-19 as a reason for non-use. This is what was said in that case:

> The Covid 19 pandemic started circulating in the UK in January 2020 with the first national lockdown occurring in March 2020.
>
> In relation to providing reasons for non-use in *Armin Haupl v. Lidl Stiftung & Co. KG*, Case C-246/05, the court of Justice of the European Union held:
>
> > It follows that only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as "proper reasons for non-use" of that mark.
>
> ... A passing reference to these events, in isolation, without further clarification, as to how these events impacted upon the Proprietors businesses (especially given that it is not clear what the Proprietors' businesses are), are insufficient in themselves, without further explanation, to demonstrate non-use of the marks for the goods and services in question.

[56] Here, apart from incorporating Copper Chimney Sdn Bhd on 27 June 2019, the defendant did not adduce any evidence of even being near to opening a restaurant using the defendant's mark up to the time the plaintiff filed this OS, or details of how the pandemic had stopped it in its tracks.

[57] Sixthly, the defendant has not disclosed any further developments after the letter of intent dated 7 April 2023 and the partnership proposal dated 2 May 2023. The latter was almost three months before the OS was filed and was expressed to be valid until 2 November 2023. Surely if the plaintiff were serious about opening a Copper Chimney restaurant locally there would have been some developments.

[58] I accordingly find that the defendant has not made out any proper reasons for non-use of the defendant's mark in services in class 43.

Conclusion

[59] In conclusion, I find that the plaintiff is an aggrieved person, and has established *prima facie* that the defendant did not use the defendant's mark for services in class 43 during the periods of either 28 September 2015 to 27 September 2018 or 26 July 2020 to 25 July 2023. I further find that the defendant failed to show any use of the defendant's mark since it was registered or provide any proper reasons for such non-use. Thus, the plaintiff is entitled to revoke the defendant's mark under s. 46 of the Act.

Invalidation Of The Defendant's Mark

[60] For invalidation of the defendant's mark, the intitulement to the OS mentions ss. 47(1), (3) and (6), and ss. 76(3) and (4) of the Act.

[61] Section 47(1) of the Act expressly provides: A

> The registration of trademark may be declared invalid by the court upon the application by an aggrieved person on the ground that the trademark was registered in breach of s. 23.

[62] Section 23 of the Act that is mentioned in s. 47(1) concerns absolute grounds for the Registrar to refuse to register a trademark. In its written submissions, the plaintiff honed in on sub-s. (5)(a) of s. 23, which provides that a Registrar shall refuse to register a trademark: B

> if the use of the trademark is likely to deceive or cause confusion to the public or contrary to any written law. C

[63] Section 47(3) of the Act expressly provides

> The registration of trademark may be declared invalid by the court upon the application by an aggrieved person on the ground that:
>
> (a) there is an earlier trademark under sub-s. 24(1), (2) or (3); or D
>
> (b) there is an earlier right under sub-s. 24(4).

[64] Of the four subsections of s. 24 of the Act that these provisions mention, in its written submissions the plaintiff honed in on s. 24(3) of the Act which provides:

> The Registrar shall refuse to register a trademark if: E
>
> it is identical with or similar to a well-known trademark which is not registered in Malaysia and it is to be registered for the identical goods or services of the proprietor of the well-known trademark.

[65] Section 47(6) of the Act expressly provides: F

> The registration of trademark may be declared invalid by the court upon the application by an aggrieved person or the Registrar on the ground of fraud in the registration or that the registration was obtained by misrepresentation.

[66] Section 76(3) of the Act expressly provides: G

> A proprietor of a well-known trademark may apply to the court for a declaration of invalidation of a registered trademark on the grounds that the registered trademark is identical with or similar to a well-known trademark in Malaysia and the registered trademark is registered for any goods or services which are not identical or not similar to those in respect of the well-known trademark: H
>
> (a) If the use of the registered trademark in relation to those goods or services would indicate a connection between those goods or service and the proprietor of the well-known trademark;
>
> (b) there exists a likelihood of confusion on the part of the public because of such use; and I
>
> (c) the interests of the proprietor of the well-known trademark are likely to be damaged by such use.

[67] Section 76(4) of the Act expressly provides:

> A proprietor of a well-known trademark may apply to the court for a declaration of invalidation of a registered trademark on the grounds of fraud in the registration or that the registration was obtained by misrepresentation.

[68] Like s. 46(1) of the Act, under sub-s. (1), (3) and (6) of s. 47 of the Act the applicant must be an aggrieved person. The concept of aggrieved person under both ss. 46 and 47 of the Act is the same. Consequently, as I had already earlier found that the plaintiff is an aggrieved person for its revocation application under s. 46(1) of the Act, it would likewise be an aggrieved person for its invalidation application under s. 47 of the Act. So I need not go into that issue again.

[69] In respect of an application under s. 47(3) read with s. 24(3) of the Act, and under ss. 76(3) and (4) of the Act, an applicant would have to show that its trademark is a well-known trademark. In fact, from the plaintiffs written submissions, this notion of well-known trademark was the mainstay of its case for invalidation of the defendant's mark.

[70] In para. 53 of the plaintiffs written submissions, the plaintiff submitted that the defendant's mark should be invalidated under s. 47(1), (3) and (6) on the following grounds:

(i) that it is identical and/or similar to a well-known trademark which is not registered in Malaysia and registered for identical goods or services, pursuant to s. 47(3) read together with s. 24(3) of the Act;

(ii) that use of the defendant's is likely to deceive or cause confusion to the public pursuant to s. 47(1) read together with s. 23(5)(a) of the Act; and

(iii) that the defendant's registration was obtained by fraud or misrepresentation pursuant to s. 47(6) of the Act.

[71] Then, in paras. 55-56 of the plaintiffs written submissions, the plaintiff alluded to the ability of the proprietor of a well-known mark being able to apply under ss. 76(3) and (4) of the Act for a declaration of invalidation of a registered trademark.

[72] As the plaintiff's invalidation application predominantly involves the notion and concept of "well-known trademarks", it would be appropriate and opportune at this juncture to clarify what that means and entails.

[73] Section 4 of the Act provides a definition of "well-known trademark":

> (1) "Well-known trademark" means any trademark that is well-known in Malaysia and that belongs to a person who:
>
> (a) is a national of a Convention country; or
>
> (b) is domiciled, or has a real and effective industrial or commercial establishment, in a Convention country,

whether or not that person carries on business, or has any goodwill, in Malaysia. A

(2) In determining whether a trademark is well-known in Malaysia, the Registrar or the court shall have regard to the criteria as prescribed.

[74] The "criteria as prescribed" that said s. 4(2) speaks of are set out in reg. 5 of the Trademarks Regulations 2019 ("Regulations"), but they are by no means exhaustive. Said reg. 5 provides: B

Criteria of well-known trademark

In determining whether a trademark is known in Malaysia, the Registrar or the court shall have regard to the following criteria: C

(a) the extent of knowledge or recognition of the trademark in the relevant sector of the public;

(b) the duration and extent, and geographical area of any use of the trademark;

(c) the duration and extent of any promotion of the goods or services where the trademark applies and the geographical area where the promotion is carried out; D

(d) the duration and place of registration, or duration and place of application for registration, of the trademark, to the extent that they reflect use or recognition of the trademark; E

(e) the record of successful enforcement of rights in the trademark, in particular, the extent to which the trademark was recognized as well-known by competent authorities; and

(f) the value associated with the trademark. F

[75] As the plaintiff is contending that the plaintiff's marks are well-known trademarks in Malaysia, then it bears the burden of establishing so. In *TCE Sports Sdn Bhd v. Bullzen Sport (Malaysia) Sdn Bhd* [2023] CLJU 379; [2023] 1 LNS 379, Quay Chew Soon J said (in paras. [80] and [85] of his judgment: G

... Secondly, "well known" in law has a very different meaning and effect. P is not entitled to this relief without fulfilling all the requirements under the TMA 2019 and the Trademarks Regulations 2019.

... A person alleging a particular fact that his trademark is well-known in this country, has the legal burden under s. 103 of the Evidence Act 1950 to prove such a fact. H

[76] Further, in this case the plaintiff must prove that the plaintiff's marks were well-known trademarks in Malaysia by 14 July 2014, being the date that the defendant had applied to register the defendant's mark. It certainly cannot rely on any evidence beyond that date because, if that were so, then every trademark registered in Malaysia would be susceptible to being I

challenged for invalidation by a similar or identical trademark registered anywhere in the world that might only have become well-known long after the registration of that Malaysian trademark.

[77] That the plaintiff must prove that the plaintiff's marks were well-known trademarks by 14 July 2014 is also evident from s. 76(5) of the Act, which provides:

> The proprietor of a well-known mark shall not be entitled to the right referred to in sub-s. (2) if the use of the trademark began before the proprietor's trademark became well-known in Malaysia unless the trademark has been used in bad faith.

[78] In support of the OS, the plaintiff filed two affidavits with multiple documentary exhibits in three volumes running to well over 1,000 folios (collectively, "plaintiff's affidavit"), proffering several grounds for contending that the plaintiff's marks are well-known. On those grounds and documents, I make several observations and findings.

[79] Firstly, exh. U to the plaintiff's affidavit shows that, even though the plaintiff alleges that it had used the name "Copper Chimney" from the commencement of operations when it opened its first restaurant in Bombay in 1972, as at 14 July 2014 the plaintiff was operating only that solitary restaurant, which the documents refer to as 'Copper Chimney WORLI'. All of its other 24 restaurants operating under the Copper Chimney name in India (20), UAE (2), UK (1) and Kuwait (1), all of which use the plaintiff's marks, were opened onwards from 5 December 2016. That date was when the plaintiffs second restaurant opened, in Pune, India. The plaintiffs first Copper Chimney outlets beyond the shores of India opened only in 2020, in London, Dubai, and Kuwait. That the plaintiff had only ventured outside of India in 2020 with its Copper Chimney restaurant is evidenced by the data in exh. G to the plaintiff's affidavit that international sales only started generating in 2020-2021.

[80] Secondly, exh. U to the plaintiff's affidavit shows that, despite opening its first restaurant in 1972, the plaintiff only began registering the plaintiff's mark in 1987, with the first registered in 6 March 1987. Even though from 1987 up to now the plaintiff has registered 30 trademarks in India that contain the word "Copper Chimney", as at 14 July 2014, only 18 of those had been registered. Even then, none of those trademarks were registered in class 43, not even the ones registered in 1987. The plaintiff registered two of the plaintiff's marks in class 43 for the first time only on 18 September 2017, which was over three years after the date the defendant's mark was registered in Malaysia in class 43, and 45 years after the plaintiff opened its first restaurant in Bombay in 1972.

[81] Thirdly, exh. U to the plaintiff's affidavit also shows that, outside of India, as at 14 July 2014, the plaintiff had registered the plaintiffs marks in UAE (2010), Kuwait (2011), Australia (2013) and the UK (2013). However,

exh. E to the plaintiff's affidavit shows that the first of its three restaurants in UAE (one of which closed in July 2022) and its sole restaurant in Kuwait opened only in August 2020, its sole restaurant in the UK opened in October 2020, and there was no evidence of any Copper Chimney restaurant having ever been opened in Australia until now. This means that, despite registering those trademarks in those countries, there was non-use of the plaintiff's marks in UAE, Kuwait, and the UK for at least a decade before the plaintiff actually opened those restaurants and put the plaintiff's marks to actual use. And as the plaintiff has never actually opened a Copper Chimney restaurant in Australia, there has been no actual use at all of the plaintiff's marks down under. Evidently, those same arguments of non-use in Malaysia which the plaintiff argues against the defendant would apply to the plaintiff in all of those countries. In addition, the plaintiff also did not adduce any evidence that the plaintiff's marks had become well-known trademarks in those countries either. Or even in India for that matter by the time the defendant's mark was registered in Malaysia.

[82] Fourthly, in respect of the plaintiff's evidence on its alleged expenditure incurred in promoting, marketing and advertising its Copper Chimney restaurants, including online and through social media, according to my calculations, the plaintiff spent US$809,946 for the years 2007-2023. However, only around 3% of that was spent between 2007-2015. Thus, 97% of that expenditure was actually incurred after the defendant's mark was registered.

[83] Fifthly, in respect of sales generated, exh. G to the plaintiff's affidavit shows that, between 2007-2015, the total generated sales was US$28,902,349, while the total generated sales for 2007-2023 was US$78,229,509. This means that at least two-thirds of its sales were generated after the defendant's mark was registered. Even then, exh. U to the plaintiff's affidavit shows that, in all, the plaintiff has registered the plaintiff's marks in 14 other classes apart from class 43 (*ie*, classes 12, 16, 18, 19, 21, 24, 29, 30, 31, 32, 33, 34, 39 and 42) and by 2014 the plaintiff had opened only one restaurant in Bombay. There is no evidence that those profits were generated from the plaintiff's Bombay restaurant alone.

[84] As for being featured in the press and in magazines, the plaintiff adduced just a few articles in India from before 14 July 2014, and none from abroad.

[85] In respect of awards, the only award that the plaintiff adduced evidence of from before 14 July 2014 was "Best Indian Cuisine Restaurant Chain – National for 2013" by Franchise India. This can be seen from exh. F to the plaintiff's affidavit. There were no awards shown from between 1972 to 2013. Just as one swallow does not a summer make, one award does not alone make a trademark well-known.

[86] The plaintiff also did not adduce any evidence of online reviews from before 14 July 2014. The first was on 4 December 2018, posted on Tripadvisor from someone in Mumbai, India. The first review of the Copper Chimney restaurant in London was in Halalfoodguy, of a visit on 3 December 2020. Even then, in the latter, none of the food that was sampled was given a rating of over 7/10, and one was rated only 4/10.

[87] Further, the only successful prosecution of an action for infringement of the plaintiff's marks was in the Bombay High Court (commercial division), in 2018.

[88] I also note that the plaintiff only secured the use of the domain name registration for "Copper Chimney" in July 2022.

[89] Lastly, the plaintiff did not adduce any evidence of a survey having been carried out to show that its Copper Chimney restaurant or brand was well-known in Malaysia.

[90] In *Aspect Synergy Sdn Bhd v. Banyan Tree Holdings Ltd* [2009] 8 CLJ 97, the defendant alleged that its mark was a well-known trademark in Malaysia. Apart from finding that the defendant had failed to establish that its mark fulfilled the criteria form well-known trademarks set out in reg. 13B of the Trade Marks Regulations 1997 (that was in force at the time), Ramly Ali J said:

> BTHL has not produced any evidence or survey reports to show the extent of recognition the BTHL's mark has in Malaysia.
>
> There is no record of successful enforcement of rights produced or did BTHL provide any information as to the value associated with the BTHL's mark other than producing some brochures and agreements."

[91] Based on the plaintiff's own documents and evidence, I find that the plaintiff has failed to adduce any sufficient evidence for this court to hold that any of the plaintiff's marks were well-known trademarks as at 14 July 2014.

[92] Consequently, as the plaintiff's application to invalidate the defendant's mark under s. 47(3) read with s. 24(3) of the Act and ss. 76(3) and 76(4) of the Act first require the plaintiff to establish that the plaintiff's marks were well-known trademarks as at 14 July 2014 and the plaintiff has failed to do so, I find that the plaintiff's attempt to invalidate the defendant's mark under these provisions of the Act fail.

[93] I also note that, despite both ss. 76(3) and 76(4) of the Act stating that the proprietor of a well-known trademark "may apply to the court for a declaration of invalidation of a registered trademark", the plaintiff did not even apply for that declaration in the OS. Since those provisions expressly provide for such a declaration, I would think that specifically applying for that has to be par for the course in order for the court to so order, if the case had been made out.

[94] That now leaves the court having to consider the plaintiff's application to invalidate the defendant's mark under ss. 47(1) and 47(6) of the Act. Invalidation under s. 47(1) (read with s. 23(5)(a)) of the Act. A

[95] Section 47(1) of the Act expressly provides:

> The registration of trademark may be declared invalid by the court upon the application by an aggrieved person on the ground that the trademark was registered in breach of s. 23. B

[96] Sub-section (5)(a) of s. 23 that the plaintiff focused on in its written submissions provides that a Registrar shall refuse to register a trademark:

> if the use of the trademark is likely to deceive or cause confusion to the public or contrary to any written law. C

[97] The purpose and rationale of this provision is to protect the public. The use of a trademark is likely to deceive or cause confusion to the public if it is identical with or similar to a trademark already used by another trader, regardless of whether or not the trademark is used in Malaysia. D

[98] In *Yong Teng Hing B/S Hong Kong Trading Co & Anor v. Walton International Ltd* [2012] 6 CLJ 337; [2012] 6 MLJ 609, Zulkefli CJ (Malaya) said:

> As regards the test of confusion and deception it is now well settled. The decision of the House of Lords in the case of *Bali Trade Mark* [1969] RPC 472 in interpreting s. 11 on the UK Trade Marks Act which is equivalent to our s. 14(1)(a) of the Act is highly instructive. Lord Upjohn held in that case at p. 496 on the test of likelihood of confusion and deception, as follows: E
>
> > What then, is the test? This must necessarily be a question of fact and degree in every case ... It is not necessary in order to find that a mark offends against s. 11 to prove that there is an actual probability of deception leading to passing off or (I add) an infringement action ... It is sufficient if the result of the registration of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products came from the same source. F G

[99] In *"ELBA" SpA v. Fiamma Sdn Bhd* [2008] 8 CLJ 202; [2008] 3 MLJ 713, Ramli Ali J said:

> The element of confusion only comes in when goods belonging to two different proprietors with similar marks are competing in the same market in the course of trade. There would not be any confusion because the applicant has never used the 'ELBA' mark in the course of trade in Malaysia. H

[100] Given that, at the time the defendant applied to register the defendant's mark, the plaintiff was only operating one restaurant outlet in India and had not opened any outlets outside of India, and had not actually I

put to use the trademarks it had registered in UAE, Kuwait or Australia, I find that, even if the defendant had used the trademark in Malaysia upon it being registered, that use would not likely deceive or cause confusion to the public or contrary to any written law.

[101] Consequently, the plaintiff's application to invalidate the defendant's mark under s. 47(1) read together with s. 23(5)(a) of the Act fails.

Invalidation Under s. 47(6) Of The Act

[102] Section 47(6) of the Act expressly provides:

> The registration of trademark may be declared invalid by the court upon the application by an aggrieved person or the Registrar on the ground of fraud in the registration or that the registration was obtained by misrepresentation.

[103] To successfully invoke this provision, the plaintiff would have to establish that, at the time the defendant applied to register the defendant's mark in Malaysia, it practiced a fraud or misrepresentation upon the Registrar.

[104] In *Hai-0 Enterprise Bhd v. Nguang Chan* [1992] 4 CLJ 1985; [1992] 2 CLJ (Rep) 436, Mahadev Shankar said:

> I say this because the fraud that is here referred to is not just the fraud on the foreign manufacturer. It is the fraud on the Registrar and through the Registrar on other traders and the Malaysian public.

[105] In *Tiga Gajah Cho Heng Sdn Bhd v. Majuperak Tepung Beras Sdn Bhd* [1997] 1 CLJ Supp 52; [1997] 1 BLJ 52; [1997] 4 MLJ 504, Kamalanathan Ratnam JC expounded on what "fraud" entailed. He said:

> Coming to the issue of fraud, I hold that fraud as stated in s. 37 of the TMA 1976 must and ought to reflect the ordinary meaning ascribed to it and therefore show conduct involving dishonesty or deception, by word or deed or omission by word or deed.
>
> The dishonesty must not be assumed solely by reason of knowledge of an unregistered interest. It is right in my view to give example as to what may constitute fraud by way of illustrative hypothetical conditions because each case must depend upon its own specific set of facts. I am fortified in the view that I hold by relying of *Farley (Aust) Pty Ltd v. JR Alexander & Sons (Q) Pty Ltd* (1946) 75 CLR 487, where in Williams J said at p. 492:
>
> > *Prima facie* the words of a statute should be given their ordinary grammatical meaning. The ordinary meaning of fraud involves 'dishonesty or grave moral culpability' (see *Re Avery's Patent*).
> >
> > What therefore emerges from these cases is the crystallisation of three elements to co-exist in establishing fraud in respect of s. 37 of the TMA 1976.

For fraud to subsist, there must be:

(1) an actual deception and intention to deceive;

(2) an actual injury or possible injury by means of deceit; and

(3) actual knowledge that the act was calculated to injure one's neighbour.

[106] In *"ELBA" SpA*, *supra*, Ramli Ali J adopted these same three criteria for determining whether fraud had been made out in that case.

[107] Given that, at the time the defendant applied to register the defendant's mark, the plaintiff was only operating one restaurant outlet in India and had not opened any outlets outside of India, and had not put to actual use the trademarks it had registered in the UAE, Kuwait and Australia, and was that the plaintiff's marks were not well-known trademarks, I find that there was no fraud by the defendant in the registration of the defendant's mark in Malaysia, and that the registration of the defendant's mark in Malaysia was not obtained by misrepresentation, on either the Registrar or on the general public.

Conclusion

[108] In conclusion, as the plaintiff's application to invalidate the defendant's mark fails on all five provisions of the Act that it seeks to invoke, the plaintiff's application to invalidate the defendant's mark is dismissed with costs.

Relief/Orders Sought And Made

[109] In prayer 1 of the OS, the plaintiff sought the following:

A Declaration that the plaintiff is the legal owner and common law owner of the trademark "COPPER CHIMNEY" and its variant thereof where it is used in relation to its restaurant business.

[110] The plaintiff cannot be the legal owner of the "Copper Chimney" trademark in Malaysia because it was registered by the defendant, and the provisions for revocation of the defendant's mark do not have provisions empowering the court to order it transferred to the plaintiff.

[111] As for common law ownership of a trademark, it is usually dependent on which of the competing parties was the first to use the disputed mark within Malaysia.

[112] In *Fazaruddin Ibrahim*, *supra* Abdul Malik Ishak J said:

The basic common law principle is this: the first person who uses a trademark of an appropriate type within a country becomes the proprietor of the mark (*Re Registered Trade Mark 'Yanx' ex p Amalgamated Tobacco Corp Ltd* (1951) 82 CLR 199 at p 203; *Thunderbird Products Corp v. Thunderbird Marine Products Pty Ltd* (1974) 131 CLR 592 at p 603; *Moorgate Tobacco Co*

Ltd v. Philip Morris Ltd (No 2) (1984) 59 ALJR 71 at p 83). It is said that a person who becomes proprietor of a trademark in this way is entitled at common law to restrain a person who later commences to use the trademark.

[113] In *Syarikat Zamani Hj Tamin Sdn Bhd & Anor v. Yong Sze Fun & Anor* [2006] 5 MLJ 262, Ramli Ali J said:

> It is trite law that the first to use a mark in Malaysia would prevail. Otherwise it would result in an anomaly in the law in the sense that the first and original user is defeated by a subsequent user.

[114] In *Lim Yew Sing v. Hummel International Sports & Leisure A/S* [1996] 4 CLJ 784; [1996] 3 MLJ 7, Mahadev Shankar said:

> Trade mark law is very territorial in many aspects. So, it will be useful to keep in the forefront of our minds that, however distasteful it may be for a trader in one country to appropriate the mark of a foreign trader who is using that mark in a foreign country, there is nothing unlawful under the Trade Marks Act 1976 for a Malaysian trader to become the registered proprietor of a foreign mark used for similar foreign goods provided that the foreign mark has not been used at all in Malaysia.

[115] In *Mesuma Sports*, after referring to *Fazaruddin, Syarikat Zamani Hj Tamin* and *Lim Yew Sing*, Azahar Mohamed FCJ said in paras. [46] and [47] of the judgment:

> Thus, the well-settled legal requisites necessary for the acquisition of common law trademark rights over an indicator and identifier for the commencement of any passing off cause of action has always been premised on a factual requirement for the distinctive use of the indicator or identifier in a trademark sense in the course of trade.
>
> So we would hold that he who first uses a trademark owns the said trademark under common law and that such common law ownership would in turn entitle him to file for trademark application as a *bona fide* applicant, pursuant to s 25(1) of the TMA.

[116] As the plaintiff has not used a mark with "Copper Chimney" in Malaysia, it therefore cannot be the common law owner of it. This relief is refused.

[117] In prayer 2 of the OS, the plaintiff sought the following:

> An order that the defendant's Malaysian Trademark Registration as stated below have been entered into the Register of Trademarks without sufficient reason and/or wrongly remained in the Register:
>
> (a) Trademark Registration No. 2014007985 for "COPPER CHIMNEY" in class 43 filed on 14.07.2014 (hereinafter referred to as the "defendant's Malaysian Registration").

[118] The words "entered into the Register of Trademarks without sufficient reason and/or wrongly remained in the Register" are actually a throwback to the Trade Marks Act 1976 previously in force and now repealed, taken from s. 45(1)(a) of the previous Trade Marks Act 1976, which provides:

> Section 45. Rectification of the Register
>
> (1) Subject to the provisions of this Act:
>
> (a) the court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the Register of any entry or by any entry made in the Register without sufficient cause or by any entry wrongfully remaining in the Register, or by any error or defect in any entry in the Register, make such order for making, expunging or varying such entry as if thinks fit.

[119] Nevertheless, these words are associated with the wrongful registration of a trademark and an application to invalidate that registration.

[120] As I had found that the plaintiff's application to invalidate the defendant's mark failed, this relief is also refused.

[121] In prayer 3 of the OS, the plaintiff sought the following:

> An order under Section 46(1)(a) & (b), Section 47(1), (3) & (6) and/or Section 76(3) & (4) Trademarks Act 2019 that the defendant's Malaysian Registration be revoked, invalidated and/or removed from the Trade Marks Register.

[122] As I had found that the plaintiff had succeeded only in its application to revoke the defendant's mark under ss. 46(1)(a) & (b) of the Act, only that part of prayer 3 of the OS relating to revocation of the defendant's mark is allowed.

[123] In prayer 4 of the OS, the plaintiff sought the following:

> An order for the Registrar of Trade Marks from MyIPO to record the revocation/invalidation of the defendant's Malaysian Registration in the Register of Trade Marks.

[124] As the plaintiff had succeeded in its application to revoke the defendant's mark under ss. 46(1)(a) & (b) of the Act, only that part of prayer 4 of the OS in relation to recording the revocation of the defendant's mark in the Register is allowed.

[125] In prayer 4 of the OS, the plaintiff sought an order for the defendant to pay it costs. Under O. 59 r. 3 of the Rules of Court 2012, costs will usually follow the event (*ie*, the successful party is awarded costs) "except where it appears to the court that in the circumstances of the case some other order should be made as to the whole or any part of the costs."

[126] In my view, although the plaintiff succeeded in making a case for revoking the defendant's mark, this is a case in which costs should not follow the event. The plaintiff's affidavit and exhibits (that ran to three volumes) and its written submissions were devoted substantially to its case for attempting to establish that the plaintiff's marks are well-known trademarks and for invalidating the defendant's mark under those five provisions of the Act that I mentioned earlier. It failed in that endeavour. As such, in my view, the defendant should not be ordered to pay the plaintiff any costs.

[127] Accordingly, I made the following orders:

(i) An order under s. 46(1)(a) & (b) of the Trademarks Act 2019 that the defendant's Trademark Registration No: 2014007985 for:

COPPER CHIMNEY

be revoked from the Register of Trademarks kept and maintained by the Registrar of Trademarks under the Trademarks Act 2019;

(ii) That upon service of this order on the Registrar of Trademarks in accordance with reg. 52 of the Trademarks Regulations, the Registrar of Trademarks shall record the revocation of the defendant's Trademark Registration No: 2014007985 and thereafter cause such fact of revocation to be published in the Journal;

(iii) That the plaintiffs application to invalidate the defendant's Trademark Registration No: 2014007985 under the provisions of the Trademarks Act 2019 be dismissed; and

(iv) That there be no order as to costs of this action.